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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/029,553	12/20/2001	Matthew J. Birdsall	P105 CON 3	6097

28390 7590 06/28/2005
MEDTRONIC VASCULAR, INC.
IP LEGAL DEPARTMENT
3576 UNOCAL PLACE
SANTA ROSA, CA 95403

EXAMINER

THALER, MICHAEL H

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 06/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/029,553

Applicant(s)

BIRDSALL ET AL.

Examiner

Michael Thaler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-25,28,31,32 and 36-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-25,28,31,32 and 36-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/25/05
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on Nov. 22, 2004 has been entered.

The declaration filed on Nov. 22, 2004 under 37 CFR 1.131 has been considered but is ineffective to overcome the Alt et al. (5,843,117) reference.

The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Alt et al. reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). Nothing in the two pages from the laboratory notebook is seen which describes the transverse cross section of a stent strut as having a substantially flat top side, a substantially flat bottom side and substantially curved

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left and right sides as recited in paragraph 2 of the declaration.

The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the Alt et al. reference for the reasons set forth in the paragraph above.

The declaration is not signed by all of the inventors.
Note M.P.E.P. 715.04.

The declaration fails to contain an allegation that the acts relied upon to establish the date prior to the reference were carried out in this country or in a NAFTA country or WTO member country. Note M.P.E.P. 715.07(c).

The disclosure is objected to because of the following informalities: On page 12, second full paragraph, "and/or with the surfaces of the top and bottom portions exhibiting substantially similar absolute radii of curvature" is inconsistent with figures 3A and 3B which show the top and bottom portions as being substantially flat. Appropriate clarification or correction is required.

The foreign patent cited in the information disclosure statement filed Jan. 25, 2005 has not been considered since no copy of it was submitted.

Claims 37, 38 and 40 are rejected under 35 U.S.C. 102(e) as being anticipated by Summers (6,080,191). Summers shows a stent comprising at least one strut having a transverse cross section (shown in figure 19A), the transverse cross section having a top substantially flat side (at the top of figure 19A), a bottom substantially flat side (at the bottom of figure 19A), a right substantially flat side (at the right of the figure) and a left substantially flat side (at the left of the figure).

Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Disclosure in view of Alt et al. (5,843,117). Applicant admits that the stent shown in figure 2C of applicant's disclosure is prior art. This shape fails to include a smooth rounded edge between the sides. However, Alt et al. teaches that a stent should be machined to round all of its sharp corners in order to facilitate easy movement of the stent through the blood vessel and prevent damage to the blood vessel or balloon (col. 6, lines 31-45, col. 14, lines 60-62 and col. 15, lines 16-18). It would have been obvious to round the corners of the prior art stent shown in figure 2C of the application so that it too would have these advantages.

Claims 20-25, 28, 31, 32, 36 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Summers (6,080,191) in view of Alt et al. (5,843,117). Summers shows a stent

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comprising at least one strut having a transverse cross section (shown in figure 19A), the transverse cross section having a top substantially flat circumferential side (at the top of figure 19A), a bottom substantially flat circumferential side (at the bottom of figure 19A), a right side (at the right of the figure) and a left side (at the left of the figure). Summers fails to show the left and right sides as being substantially curved. However, Alt et al. teaches that a stent should be machined to round all of its sharp edges in order to facilitate easy movement of the stent through the blood vessel and prevent damage to the blood vessel or balloon (col. 6, lines 31-45, col. 14, lines 60-62 and col. 15, lines 16-18). It would have been obvious to round the left and right sides (i.e. the left and right edges) of the Summers stent shown in figure 19A so that it too would have these advantages. As to claims 20 and 31, note that the Summers strut 150 is so thin as compared to its width (as shown in figure 19A), that the left and right sides shown in this figure are edges. Thus, when following the Alt et al. teaching of round all of sharp edges of a stent strut, it would have been obvious to round the entire left and right sides (edges) of the Summers strut 150. As to claim 21, Summers, in figure 21, shows a plurality of straight sections i.e. the sections of spine 162 between the looped ribs (161 in the figure

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or 164 in the specification) joined by a plurality of crown sections i.e. the looped ribs 161, 164 as broadly claimed. As to claim 24, Summers, in figure 17, shows stent 122 fused to a second stent 126. As to claim 28, Summers discloses a self expanding stent in col. 5, lines 19-22.

Applicant's arguments filed Nov. 22, 2004 have been fully considered but they are not persuasive for the reasons set forth above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Thaler whose telephone number is (571)272-4704. The examiner can normally be reached Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on (571)272-4963. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9306.

mht
6/22/05



MICHAEL THALER
PRIMARY EXAMINER
ART UNIT 3731